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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,129	10/14/1998	YASUHIRO SUZUKI	9829-0001-OX	1274
22850	7590	07/28/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCDOWELL, SUZANNE E	
			ART UNIT 1732	PAPER NUMBER
DATE MAILED: 07/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/147,129	SUZUKI ET AL.	
	Examiner	Art Unit	
	Suzanne E. McDowell	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 13-20, 23, 25, 26, 32, 33, 35-40, 49-53, and 58 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 12, 21, 22, 24, 27-29, 34, 41-48 and 54-57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/04 and 2/9/04</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-7, 13-16, 25, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54-047771 in view of Hwang et al. (US Patent 5,424,362). JP 54-047771 discloses a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same. Using the same resin for the molding and the coating would result in the claimed affinity, nature, and compatibility. JP 54-047771 further discloses that the resins may be polyolefin, acrylic, vinyl, polyesters, etc. Hwang et al. teaches a composition that can be recycled and melt extruded, i.e., is capable of repeatedly molding, which is compatible to the polymer formulation used for the molding (column 7, lines 25-38). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the composition taught by Hwang et al. to further define the method taught by JP 54-047771, in order to form parts that are recyclable and moldable after recycling.

JP 54-047771 discloses a method of coating the surface of a thermoplastic resin molding with a resin that is compatible with the thermoplastic utilized for the molding, where both resins are preferably the same. JP 54-047771 does not specifically teach that the molding is coated on an outer surface or an "outer or inner surface". It is generally well known in the art that a coating is applied to the surface of a molding. It would have been obvious to a person of ordinary skill in the art at the time of the invention to further define the method taught by JP 54-047771 and coat the outer surface or an "outer or inner surface" of the molding, in order to obtain a coated surface.

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3. Claims 17-20, 23, 26, 32, 33, 49-53, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieberman (US Patent 5,569,713) in view of Hwang et al. (US Patent 5,424,362). Lieberman teaches a basic method of recycling, as well as testing the characteristics of the recycled material, wherein the material may be a coated material such as a bumper formed with a foamed polypropylene core and a polyurethane shell (column 5, lines 50-54), or may be a resin or blend of resins (column 5, lines 10-49). Lieberman teaches collecting recycled material (10, 12, 14); particularizing the material (step 16); testing the material (18) to determine its physical properties); possibly adding additives (22) to the material, such as at least 1% by weight of a compatibilizing agent (column 3, lines 60-62); compounding the material in an extruder (38); subjecting the material to heat, pressure and shear force to liquefy and completely mix the material (column 7, lines 5-25); pelletizing the material (26); forming the pellets into test samples and testing the properties (28); depending upon the results of the tests, adding virgin material (30) and forming finished parts, or beginning again at step 22 (column 8, lines 40-54). Lieberman does not teach that the coated material is coating with a resin with the properties of the claimed affinity, nature, and compatibility. Hwang et al. teaches a composition that can be recycled and melt extruded, i.e., is capable of repeatedly molding, which is compatible to the polymer formulation used for the molding (column 7, lines 25-38). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the composition taught by Hwang et al. to modify the method taught by Lieberman, in order to avoid having unmoldable material, such as paint, in the final pellets. (Lieberman column 7, lines 53-56).

Allowable Subject Matter

4. Claims 4, 8, 12, 21, 22, 24, 27-29, 34, 41-48, and 54-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne E. McDowell whose telephone number is (571) 272-1205. The examiner can normally be reached on M, W, Th 6:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianne can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEM
July 26, 2004



SUZANNE E. MCDOWELL
PRIMARY EXAMINER